

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Yoshitaka MISHIMA *et al.* : Confirmation No. 8783
U.S. Patent Application No. 10/686,812 : Group Art Unit: 3761
Filed: October 17, 2003 : Examiner: Jacqueline F. Stephens
For: DISPOSABLE WEARING ARTICLE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

By Official Action mailed April 7, 2006, restriction to one of the following species of the claimed invention is required:

- Species 1. Figure 4
- Species 2. Figure 5
- Species 3. Figure 6
- Species 4. Figure 7
- Species 5. Figure 9
- Species 6. Figure 10
- Species 7. Figure 11

In response, Applicants hereby elect Species 1 (FIG. 4), upon which claims 1-2, 4-6, 8, 11-12 and 22 are readable. Claims 1, 4, and 12 are generic claims.

The election is made *with traverse* because the Examiner has failed to follow proper USPTO practice and procedure.

Every requirement to restrict has two aspects:

(A) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct; and

(B) the reasons for insisting upon restriction therebetween. See MPEP, section 808 (emphasis added).

In this case, the Restriction Requirement has not specified with reasonable clarity the reasons *why* the species are considered independent or distinct (requirement A).

In addition, the Restriction Requirement has also failed to specify any reason for insisting upon restriction (requirement B).

The Examiner is further kindly reminded that if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. *See MPEP*, section 803.


In this case, Applicants note that the Examiner has demonstrated, in the Office Action dated October 6, 2005, her ability to examine the original claims drawn to all species. In particular, Species 1 was covered by at least original claim 2, Species 2 was covered by at least original claim 9, Species 3 was covered by at least original claim 10, Species 4, 5 were covered by at least original claim 7, Species 6, 7 were covered by at least original claims 3 and 13-18 wherein Species 7 was covered by at least original claim 16. Accordingly, Applicants respectfully submit that claims directed to all Species can be covered in a single search without serious burden, as the Examiner has demonstrated in the first Office Action, and should be examined on the merits, even if the Examiner is correct that the species are independent or distinct.

In view of the above, withdrawal of the Restriction Requirement and consideration of all claims pending in the instant application are believed appropriate and therefore courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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